

REMARKS

This paper is in response to the Office action mailed July 9, 2009 ("the Office Action"). No claims are amended. Claims 1-40 remain pending, of which claims 1, 23, and 28 are independent. Applicants respectfully request reconsideration of the application in view of the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Finality Precluded

If the next office action rejects any of claims 1-40 using a new ground of rejection, the next office action must be nonfinal because the current Office Action fails to establish a *prima facie* case that claims 1-40 are obvious over *Creedon* and *Miesterfeld*. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the present

case, if the next office action rejects any of claims 1-40 using a new ground of rejection, such a rejection would not be necessitated by this response because none of the rejected claims was amended in order to distinguish over *Creedon* and *Miesterfeld*, as explained in the following remarks. Moreover, this new rejection would not have been based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) because no information disclosure was filed and/or none was filed with the fee. Accordingly, under MPEP §706.07(a), the next Office Action must be non-final if it rejects any of claims 1-40 using a new ground of rejection.

Rejection under 35 U.S.C §103(a)

The Office action rejects claims 1-5, 8-10, 12, 13, 23-26, and 28-30 under 35 U.S.C §103(a) over *Creedon et al.* (U.S. Patent No. 6,385,669) in view of *Miesterfeld* (U.S. Patent No. 4,706,082) and rejects claims 6, 7, 11, 14-22, and 31-40 under 35 U.S.C §103(a) over *Creedon* and *Miesterfeld* in view of what is purportedly “well known in the art.” Applicants respectfully traverse the rejection.

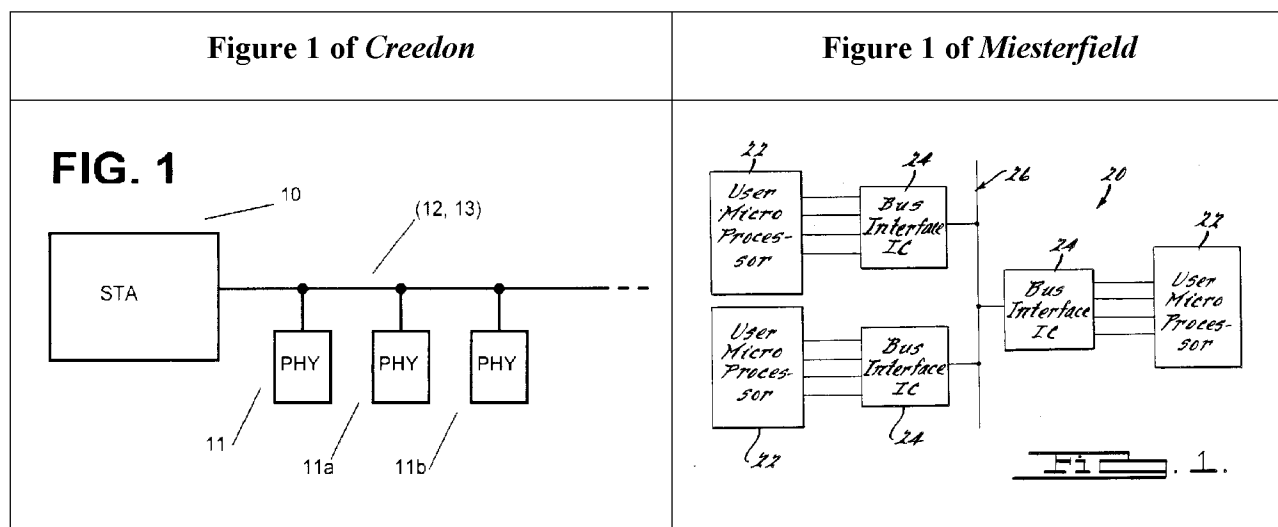
To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered.” Further, the Board of Patent Appeal and Interferences recently confirmed that a proper, post-KSR obviousness determination requires “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008), citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

In rejecting independent claims 1, 23, and 28, the Examiner alleged *Creedon* discloses “a method for [a] master component communicating over [a] data wire [with slave components]..., the method comprising...detecting at least [a] predetermined number of consecutive bits of the same binary polarity have occurred on the data wire during the act of monitoring the data wire.” See *Office Action* at 2 and 3 (claim 1), at 4 (claim 23), and at 5 (claim 28). The Examiner then acknowledged that *Creedon* does not disclose “wherein at least a portion of the consecutive bits do not originate from the master component.” See *id.* However, according to the Examiner,

"Miesterfield discloses a similar bus structure as Creedon [and] explains multiple devices can send a logic zero and a logic one can appear on the bus when the bus is idle or a device is sending a logic one." *See id.* The Examiner then concluded, "It would have been obvious...to combine the teachings of Creedon and Miesterfield so that contention can be avoided by making sure the bus is idle before sending data." *See id.* Applicants respectfully disagree.

The Examiner has implied, without basis, that the management data input/output (MDIO) bus of *Creedon* suffers a deficiency with respect to avoiding "contention" on the data line. While the problem of data line "contention" is discussed and addressed by *Miesterfield* (*see, e.g., Abstract*), *Creedon* describes a fundamentally different bus scheme and therefore does not suffer the same "contention" problems. Consistent with the Examiner's characterization of station management entity 10 in *Creedon* as a "master component" and physical layer devices 11 as "slave components" (*see Office Action at 2*), the components in the MDIO bus of *Creedon* do not contend for use of the bus. Instead, the MDIO bus is "driven" by station management entity 10. *See Creedon at col. 1, lines 5-12.*

Figure 1 of each reference is presented below for convenient comparison of the contrasting bus structures. As depicted in Figure 1 of *Creedon*, station management entity 10 drives the MDIO bus to which various physical layer devices 11 are selectively coupled. In contrast, the user microprocessors 22 connected to the bus in *Miesterfield* "operate independently of each other." *See Miesterfield at col. 1, lines 67 and 68.*



Because the MDIO bus of *Creedon* does not suffer any "contention" problems like those described in *Miesterfield*, no basis exists for modifying *Creedon* with *Miesterfield* "so that contention can be avoided," as alleged by the Examiner. Therefore, Applicants respectfully submit that no *prima facie* case of obviousness has been established. Accordingly, the rejection of claims 1, 23, and 28, and corresponding dependent claims 2-5, 8-10, 12, 13, 24-26, 29, and 30, should be withdrawn.

With respect to dependent claims 6, 7, 11, 14-22, and 31-40, Applicants note that inasmuch as the rejection of these claims relies on the asserted obviousness of the *Creedon-Miesterfield* combination advanced by the Examiner in connection with the rejection of claims 1 and 28, the rejection of claims 6, 7, 11, 14-22, and 31-40 lacks an adequate basis for at least the reasons set forth in the discussion of claims 1 and 28 above. Accordingly, the attention of the Examiner is respectfully directed to such discussion. For example, it was noted in such discussion that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1 and 28, from which claims 6, 7, 11, 14-22, and 31-40 depend. Thus, Applicants respectfully submit that it is clear that even if the references are combined, the resulting combination fails to include all the limitations of claims 6, 7, 11, 14-22, and 31-40.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 9th day of October, 2009.

Respectfully submitted,

/Ronald J. Ward/Reg. No. 54,870

RONALD J. WARD
Registration No. 54,870
ERIC L. MASCHOFF
Registration No. 36,596
Attorneys for Applicant
Customer No. 022913
Telephone: (801) 533-9800

RJW:jbh
2543589_1.DOC